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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,960	04/04/2001	Stephen L. Mayo	A-65353-7/RFT/RMS/RMK	7447

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ROBIN M. SILVA, ESQ.
DORSEY & WHITNEY LLP
Four Embarcadero Center Suite 3400
San Francisco, CA 94111-4187

EXAMINER

KIM, YOUNG J

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/827,960

Applicant(s)

MAYO ET AL.

Examiner

Young J. Kim

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 2. NOTE: Applicants are advised of the following issues: Applicants indicate that claim 30 of the instant application had been "previously amended," wherein the sub-step (c) recites the phrase, "analyzes the interaction of each potential rotamer from said group with all or part of i) said protein backbone structure, ii) potential rotamers at each other said residue position, or iii) any rotamers from said protein, to generate a set of optimized protein sequences. Contrary to the Applicants' indication, such amendment of sub-step (c) was never presented or entered into the application. According to the prosecution history, sub-step (c) of claim 30 had been amended to recite the phrase, "analyzes the interaction of each of said rotamers with all of part of the remainder of said protein backbone structure to generate a set of optimized protein sequences." This limitation and this limitation only was presented and examined in Applicants' responses received on December 2, 2002, May 12, 2003, June 26, 2003, and September 2, 2003. Therefore, what Applicants seemed to be indicating as a "Previously Amended" claim should have been annotated as "Currently Amended." Applicants' failure to properly annotate the claim status renders the present Amendment non-responsive under the new Amendment Rule (effective July 30, 2003 (revised 37 CFR 1.121)). Similarly, claim 40 is indicated as "Currently Amended" but the sub-step (c) recites the same phrase as indicated above, without properly annotating the amendment. Additionally, even if the amendments to claims 30 and 40 were to be entered, it would raise a new issue under 35 U.S.C. 112, second paragraph for reciting the phrase, "potential rotamers at each other said residue positions," because it is not clear what the limitation is trying to achieve. Applicants are also reminded that the hand-carried substitute specification is not entered because an After Final Amendment cannot be entered in part. Since the claims of the After Final Amendment are not entered, the specification is also not entered for the reasons set forth above. Applicants are required to submit another substitute specification in their response.


Applicants indicate that Examiner had agreed to receive a hand-carried document during the September 11, 2003 telephonic interview. This appears to be a miscommunication because Examiner had advised the Applicants that the After final Amendment and all necessary documents should have been mailed in through the normal channel (see Advisory Action mailed on September 22, 2003) due to the new Amendment rule which went to effect on July 30, 2003.

Lastly, the request to use the CRF of the parent application, 09/127,926 and the paper copy of the Sequence Listing has been entered as being drawn to formal matters.

Applicants are advised that the faxing of Official documents must be sent to: 703-872-9306.

If any questions would remain, Applicants are requested to contact the Examiner at 703-308-9348.




KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

10/7/03